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NOBUHISA YODA

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22852

7590

04/07/2004

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EXAMINER

JONES, DAVID

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/386,335

Applicant(s)

YODA ET AL.

Examiner

David L Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see page 2, filed 1/7/2004, with respect to the rejection(s) of claim(s) 1-7, 9-10, and 14-19 under 102(b) and claim(s) 8, and 11-13 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Nakai et al. (US 5,946,457).

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 7, 9, and 14-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Nakai et al. (US 5,946,457).

**Regarding claim 1**, Nakai et al. discloses a document input system comprising:

at least one digital copier (fig. 11, #91-93, column 15, lines 5-38) for inputting a document image and information relating to the document image, the information including information about a transmission destination (column , lines 49-67 and column 24, lines 1-38);

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Nakai discloses that the user of one of the digital copiers wishes to have a document printed out on another machine, the interface show a list of machines available and from that list the user decides which machine to use from there the information is sent to the host computer 96, and sent to the machine that has been designated;

at least one system (#96, column 15, lines 5-38) serving as a transmission destination of the document image inputted by the at least one digital copier;

storage means (the host computer 96 includes a large hard drive, column 15, lines 39-52) for storing the document image inputted by the at least one digital copier and information relating to the document image; and

transmitting means (96a, column 20, lines 6-24) for reading the information relating to the document image stored in the storage means periodically and transmitting the document image corresponding to the read out information to one of the at least one system based on the read out information relating to the document image. As stated above the system allows for a document to be sent from a digital copier to the host computer and then to a specified different copier.

**Regarding claim 2**, Nakai et al. discloses a document input system that includes a hard drive storage and as disclosed both of digital printers 92 and 93 include memory of which the document would go first and then be transferred to the host 96, and includes an Ethernet system in addition to the telephone or ISDN system, whereby the documents can be transferred between units (column 21, lines 52-65).

**Regarding claim 3**, Nakai et al. discloses a document input system wherein the digital copier comprises:

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image input/output processing means (fig. 3, #70-72, column 7, lines 29-43) for inputting the document image;

management means (74, column 7, lines 29-43) for inputting information relating to the document image inputted by the image input/output processing means; and

image input control means (PCU, 74, column 7, lines 39-43) for determining a system which is a transmission destination of the document image inputted by the image input/output processing means based on the information relating to the document image inputted by the management means and storing the document image in the sub-storage means corresponding to the determined system.

**Regarding claim 5**, Nakai et al. discloses a document input system wherein the image input control means generates title for the document image based on information relating to a document image inputted by the management means and stores the generated title in the storage means with the document image. In column 11, lines 6-62, Nakai discloses that the system operation panel allows for individual registration, and as such it would be inherent that a document would automatically have a title generated so that the document would be able to be maintained within the system.

**Regarding claim 7**, Nakai et al. discloses a document input system, further comprising second storage means in which data storing time is longer than that of the storage means, and the transmitting means transfers the document image stored in the storage means and the information relating to the document image to the second storage means. As stated above, copiers 92 & 93 both include storage means (RAM) and the server 4 includes a high capacity hard drive (column

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14, lines 13-20) and is well known in the art that the host hard drive can be divided to further include an area that is used for long time storage.

**Regarding claim 9**, Nakai et al. discloses a document input system, Nakai does not explicitly detail that when information is inputted relating to a document prior to resetting that information is treated as information, but it would be inherent that when information is being inputted regarding a particular document that information would be acted upon as document information unless the system is reset.

**Regarding claim 14**, Nakai et al. discloses a document input method includes a host server/computer that includes the ability to perform document editing (column 14, lines 6-19).

**Regarding claim 15**, Nakai et al. discloses a document input method, as stated above, copiers 92 & 93 both include storage means (RAM) and the server 4 includes a high capacity hard drive (column 14, lines 13-20) and is well known in the art that the host hard drive can be divided to further include an area that is used for long time storage. And further Nakai states that the document can be sent to any copier or printer that is designated.

**Regarding claim 16**, Nakai et al. discloses a document input method, as is well known in the art that if a user designates a document to be sent from storage to another device the transmitting means will do so, Nakai states that a document will sent to another unit or back to the original unit as desired. And further, as is well known if the system is busy will maintain the file in storage if unable to send.

**Regarding claim 17**, Nakai et al. discloses a document input system, further comprising second storage means in which data storing time is longer than that of the storage means, and the transmitting means transfers the document image stored in the storage means and the information

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relating to the document image to the second storage means. As stated above, copiers 92 & 93 both include storage means (RAM) and the server 4 includes a high capacity hard drive (column 14, lines 13-20) and is well known in the art that the host hard drive can be divided to further include an area that is used for long time storage.

**Regarding claim 18**, Nakai et al. discloses a document input system, further comprising second storage means in which data storing time is longer than that of the storage means, and the transmitting means transfers the document image stored in the storage means and the information relating to the document image to the second storage means. As stated above, copiers 92 & 93 both include storage means (RAM) and the server 4 includes a high capacity hard drive (column 14, lines 13-20) and is well known in the art that the host hard drive can be divided to further include an area that is used for long time storage.

**Regarding claim 19**, Nakai et al. discloses a document input method comprising:  
storing a document image (fig. 11, #91-93, column 15, lines 5-38) inputted by a digital copier and information relating to the document image, the information relating to the document image including information about transmission destination; (column , lines 49-67 and column 24, lines 1-38); Nakai discloses that the user of one of the digital copiers wishes to have a document printed out on another machine, the interface show a list of machines available and from that list the user decides which machine to use from there the information is sent to the host computer 96, and sent to the machine that has been designated; and

reading the stored information (column 20, lines 6-24) relating to the document image periodically and transmitting the document image corresponding to the read out information relating to the document image to the transmission destination based on the read out information

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relating to the document image. As stated above the system allows for a document to be sent from a digital copier to the host computer and then to a specified different copier.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 6, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai et al. as applied to claims 1-3, 5, 7, 9, and 14-19 above, and further in view of Uchibori (JP 10-42114).

**Regarding claim 4**, Nakai et al. discloses a document input method that includes a system that includes a plurality of digital copiers 91-93, and a host for storing and document image processing. Nakai does not explicitly disclose a job history storage or job history management.

Whereas, Uchibori discloses a document input system, wherein the digital copier comprises: job history storage means (§ 23, transmitting management header file) for storing history of various jobs including an input of the document image; and job history management means (§ 23, management header file), it would have been obvious to one skilled in the art at the time the invention was made that if an error occurs that information would be stored in the file as well.



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Therefore, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the job history means of Uchibori with the system of Nakai.

The suggestion/motivation for doing so would have been to allow a user to keep track of any technical errors within the system, as well as maintaining control of each document.

Therefore, it would have obvious to combine Nakai with Uchibori to obtain the invention as specified in claim 4.

**Regarding claim 6**, Nakai teaches a document input method, wherein the image input control means generates title for the document image based on information relating to a document image inputted by the management means and stores the generated title in the storage means with the document image. In column 11, lines 6-62, Nakai discloses that the system operation panel allows for individual registration, and as such it would be inherent that a document would automatically have a title generated so that the document would be able to be maintained within the system. Nakai does not explicitly disclose that any priority is put on a document.

Uchibori discloses a document input system that the image input control means generates a title (§ 23) for the document based on the information relating to the document inputted by the management means and stores the same with the document image. As such it would have been obvious to one of ordinary skill in the art at the time the invention was made that a priority can be established either by the user or the system based on a particular criteria.

**Regarding claim 10**, Nakai teaches a document input method that includes a host server that could include a document filing system, although it is not disclosed.

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However, Uchibori teaches that server 4 is a filing system server to maintain the system files (paragraph 23), the files maintained based upon management information.

**Regarding claim 13**, Nakai teaches a document input method that includes a host server and Nakai suggests that other destinations can be utilized as well, therefore it would have been obvious to one of ordinary skill in the art that the destination could be a groupware server.

6. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai and Uchibori as applied to claims 1-7 above, and further in view of Aikens et al. (US 5,414,494).

**Regarding claim 8**, Nakai and Uchibori teach a system whereby documents can transfer between a plurality of units within a system. Nakai and Uchibori do not explicitly disclose what is done within the system if an error occurs. But it would have been obvious to one of ordinary skill in art at the time the invention was made that the user would be notified or appended to a management file for later reference.

Whereas Aikens et al. discloses a process whereby errors are documented and communicated across the network to another device (column 5, lines 50-67, column 6, lines 1-16).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the process of error communication of Aikens et al. in the system of Uchibori and Nakai.

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The suggestion/motivation would have been to allow for any errors in the system to be displayed on the unit or/and sent to the system to be stored for retrieval or displayed on a computer within the system.

Therefore, it would have been obvious to combine the ability of Aikens et al. with Uchibori and Nakai et al. to obtain the invention as specified in claim 8.

7. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakai and Uchibori as applied to claims 1-7, 9-10, 13-19 above, and further in view of Toyada et al. (US 5,881,233).

**Regarding claim 11 and 12**, Nakai and Uchibori teach a document input system that transfers image files to other destinations, but Nakai and Uchibori do not explicitly disclose the transfer to an email server, but does disclose the ability to generate from the image data a header management file that could be used for the subject of email.

Whereas Toyada et al. discloses an email server (fig. 1, #9A) and a process of using same (column 1, lines 38-48). Toyada et al. further defines the ability to recognize a string of characters from a document generates a destination from the string of information and further including the data with the body of the email document (column 9, lines 26-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time was made to combine the process of utilizing a file information to create an email of Toyada et al. in the system of Uchibori and Nakai.

The suggestion/motivation would have been to give the ability to send the inputted image to an email server and to further send it as an email message.

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Therefore, it would have been obvious to combine Toyada et al. with Uchibori and Nakai to obtain the inventions as specified in claims 11 and 12.

### *Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Furukawa (U.S. 6,029,238) discloses a peripheral processing apparatus and at least one information processing apparatus, interconnected through a network included is a storage means for storing control information by which the information processing apparatus controls the peripheral apparatus through the network.

Hu et al. (U.S. 5,459,579) discloses a multifunctional document processing system receives document signals from a local or a remote device and processes the document signals utilizing a host computer for transmission to the local or remote device.

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*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L Jones whose telephone number is (703) 305-4675. The examiner can normally be reached on Monday - Friday (7:00am - 3:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David L. Jones

  
EDWARD COLES  
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